The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY M. STEFAN
AND CHRISTOPHER L. OESTERLING

Appeal No. 2006-1589
Application No. 10/082,912

ON BRIEF

MAILED
JUN 29 2006
U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before THOMAS, JERRY SMITH, and BLANKENSHIP, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-12.

The disclosed invention pertains to a method and system for purchasing and replenishing wireless network calling time.

Representative claim 1 is reproduced as follows:

1. A method for purchasing and replenishing wireless network calling time, comprising:

- purchasing wireless network calling time through a Web site;

- saving data encoding the purchased calling time from the Web site to a portable networking device;
- transmitting the data encoding the purchased calling time from the portable networking device to an onboard system.

The examiner relies on the following reference:

Kiel et al. (Kiel)	US 2003/0027549	Feb. 06, 2003 (filed Jul. 30, 2001)

The following rejection is on appeal before us:

1. Claims 1-12 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kiel.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of anticipation relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer. Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the briefs have not been considered and are deemed to be waived. See 37 C.F.R. §41.37(c)(1)(vii)(2004).

It is our view, after consideration of the record before us, that the evidence relied upon by the examiner does support the examiner's rejection of claims 1-12. Accordingly, we affirm.

We consider the anticipation of the following logical groups of claims, as presented by appellants [brief, pages 12 and 15]:

- Group I: Independent claims 1, 5, and 9 stand or fall together.
- Group II: Dependent claims 2-4, 6-8, and 10-12 stand or fall together.

With respect to a rejection under 35 U.S.C. §102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. Perricone v. Medicis Pharmaceutical Corp., 432 F.3d 1368, 1375-6, 77 USPQ2d 1321, 1325-6 (Fed. Cir. 2005), citing Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc., 976 F.2d 1559, 1565, 24 USPQ2d 1321, 1326 (Fed. Cir. 1992). To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (internal citations omitted). "Every element of the claimed invention must be literally present, arranged as in the claim." Richardson v. Suzuki Motor Co., Ltd., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (internal citations omitted).

GROUP I, claims 1, 5, and 9

We consider first the examiner's rejection of claims 1, 5, and 9 that stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kiel. Group I includes independent claims 1, 5, and 9. Because independent claim 1 is the broadest claim, we will select independent claim 1 as the representative claim for this rejection. See 37 C.F.R. §41.37(c)(1)(vii)(2004).

I. Appellants argue that Kiel does not disclose "'transmitting the data encoding the purchased calling time from the portable networking device to an onboard system,'" as claimed [brief, page 12, reply brief, page 5].

In response, the examiner argues that Kiel discloses purchasing and replenishing wireless network calling time (¶0001), comprising: purchasing wireless network calling time through a Web site (¶0037), saving data encoding the purchased calling time from the Web site to a portable networking device (i.e., activity monitoring unit, ¶¶0009, 0025, and 0034), and transmitting the data encoding the purchased calling time from the portable networking device to an onboard system (i.e., client communication device, ¶¶0013 and 0036) [answer, page 4].

We note that Kiel discloses the bidirectional transmission of credit data between an activity-monitoring server utility and an activity monitoring unit [¶0027]. Kiel discloses that activity monitoring unit 116 monitors incoming and outgoing [user] communications [¶0034]. Kiel further discloses that the user's credit data is updated continuously when communication device 102 is being used [¶0036]. Kiel discloses activity monitoring unit 116 includes data

storage 118 that is used for storing credit data and billing rules associated with the client (i.e., user) [¶0036]. We note that paragraph 0036, relied upon by the examiner, explicitly discloses that the original credit data record is transmitted through the infrastructure to the client's handheld communication device 102, where the data record is stored in data storage 118 [answer, page 4, see also Kiel, ¶0036]. Kiel further discloses the transmission of credit data is performed automatically between the activity-monitoring server utility and the activity monitoring unit, in a secure (i.e., typically encrypted) manner not controlled by the user [¶0027].

As shown in Fig. 1, the transmission of data through the infrastructure follows the path where the incoming data is received by modem 110 that is connected directly to activity monitoring unit 116, which includes data storage 118. We note that Fig. 1 shows a direct connection between activity monitoring unit 116 and CPU 114. This direct connection clearly provides a conduit for transmitting data encoding the prepaid (i.e., "purchased") calling time, as transmitted from activity monitoring unit 116 (corresponding to the claimed "portable networking device") to CPU 114 of handheld client communication device 102 (i.e., corresponding to the claimed "onboard system") [Kiel, Fig. 1]. We note that CPU 114 comprises a system located onboard handheld client communication device 102.

We find that transmission of data encoding the purchased calling time necessarily occurs from activity monitoring unit 116 to CPU 114 because Kiel discloses that the user's communication activity may be terminated when the user's prepaid credit line is exhausted [¶0036]. Kiel further discloses that a message indicating an insufficient credit balance is

displayed to the user [¶0043, see also step 328, Fig. 3B]. Both of these operations require an operative coupling between activity monitoring unit 116 and onboard CPU 114, as illustrated by the direct connection shown in Fig. 1.

Accordingly, we agree that claim 1 reads upon the Kiel reference in the manner relied upon by the examiner.

II. Appellants argue that instant portable networking device 130 and instant onboard system 141/142 are not the same object and are entirely separate devices [brief, page 12, reply brief, page 5]. Appellants further assert that Kiel merely discloses a single device, specifically a client communication device 102 that is provided with an integral activity monitoring unit 116 [brief, page 13, reply brief, pages 5-7].

In response, the examiner notes that Kiel teaches the activity monitoring unit and the client communication device may be embodied as separate devices. The examiner points out that Kiel teaches the client communication device "is connected to an activity monitoring unit" [answer, page 4; see also Kiel, ¶¶ 0013 and 0025, emphasis added].

We note that Kiel explicitly teaches that the communication device is installed with, or is connected to, the activity monitoring unit [¶0009, line 5, emphasis added]. We therefore agree with the examiner that the scope of Kiel's disclosure encompasses, in at least one embodiment, a discrete communication device that is operatively connected to a discrete activity monitoring unit.

III. Appellants argue that the instant specification *defines* portable networking device 130 as containing a "wireless transceiver capable of communicating both with Internet access device 120 and with an onboard system contained in mobile vehicle 140" [brief, page 12; see also specification, page 5, lines 18-20, emphasis added]. Appellants further argue that Kiel does not teach the activity monitoring unit includes a modem, as argued by the examiner in the answer [reply brief, page 8; see also answer, page 5]. Appellants argue that Kiel actually teaches the activity monitoring unit can be combined in an integral unit with the modem [reply brief, page 8].

The examiner responds that the instant specification discloses that portable networking device 130 may be, for example, a personal data assistant (PDA), a cellular phone with memory capability, or any other appropriate device [answer, page 5, emphasis added; see also instant specification page 5, lines 16-18]. The examiner further notes that the specification discloses that portable networking device may contain "a wireless transceiver capable of communicating both with Internet access device and with an onboard system" [answer, page 5; see also instant specification page 5, lines 18-20, emphasis added]. The examiner asserts that appellants' use of the qualifier "may" in the specification does not imply an absolute feature [answer, page 5]. The Examiner maintains that Kiel's activity monitoring unit anticipates the claimed portable networking device, noting that Kiel teaches that the activity monitoring unit includes a modem and interfaces with the Internet [answer, page 5; see also Kiel, ¶ 0037].

The Court of Appeals for the Federal Circuit has determined that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the

specification. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). As pointed out by the examiner [answer, page 5], the definition in the specification that corresponds to the claimed portable networking device broadly discloses:

> Portable networking device 130 may be, for example, a personal data assistant (PDA), a cellular phone with memory capability, or any other appropriate device. Portable networking device 130 may contain a wireless transceiver capable of communicating both with Internet access device 120 and with an onboard system contained in mobile vehicle 140 [specification, page 5, lines 16-20, emphasis added].

We agree with the examiner that the supporting scope of the disclosed "any other appropriate device" is sweepingly broad [specification, page 5, lines 17 and 18, emphasis added]. While we agree with appellants that Kiel actually teaches that the activity monitoring unit can be combined in an integral unit with the modem [see ¶0037], we find this issue moot because nothing in the instant claims nor in the supporting definition argued by appellants requires the reference to show a portable networking device having a wireless transceiver (i.e., modem) capable of communicating both with an Internet access device and with an onboard system contained in a mobile vehicle [emphasis added]. We agree with the examiner that the breadth of subject matter that the claim reads upon is significantly expanded by the use of the qualifying term "may" in the supporting definition found within the specification [specification, page 5, line 18]. Accordingly, we find that the sheer breadth of the supporting disclosure strongly supports the examiner's contention that Kiel's activity monitoring unit anticipates the claimed "portable networking device" in the manner relied upon by the examiner.

IV. Appellants argue that claimed portable networking device 130 does not include any ability to monitor any activity or usage of the encoded purchased calling time – notably, the portable networking device is not the device that will use the purchased calling time [brief, page 14].

A basic canon of claim construction is that one may not read a limitation into a claim from the written description. Renishaw PLC v. Marposs Societa' per Azioni, 158 F.3d 1243, 1248, 48 USPQ2d 1117, 1120 (Fed. Cir. 1998). Patentability is based upon the claims. "It is the claims that measure the invention." SRI Int'l v. Matsushita Elec. Corp. of America, 775 F.2d 1107, 1121, 227 USPQ 577, 585 (Fed. Cir. 1985) (en banc). When making a patentability determination, the claimed invention must be compared to the prior art [emphasis added]. We note that the negative limitations argued by appellants are not claimed. Accordingly, we find that appellants are impermissibly reading negative limitations supported in the specification into the claims to avoid the prior art.

V. Appellants argue that Kiel teaches away from the desirability of using a portable networking device as an intermediary to an onboard system [brief, page 14, emphasis added].

We note that the Court of Appeals for the Federal Circuit has determined that teaching away is irrelevant to anticipation. Seachange International, Inc. v. C-Cor, Inc., 413 F.3d 1361, 1380, 75 USPQ2d 1385, 1398 (Fed. Cir. 2005), citing Celeritas Tech., Ltd. v. Rockwell Int'l Corp., 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522 (Fed. Cir. 1998); Bristol-Myers Squibb Co.

v. Ben Venue Labs., Inc., 246 F.3d 1368, 1378, 58 USPQ2d 1508, 1515 (Fed. Cir. 2001). Accordingly, we find Appellants' argument that Kiel teaches away is misplaced because the examiner has rejected the claims under 35 U.S.C. §102.

VI. Appellants argue that Kiel does not disclose an onboard system, as claimed [brief, page 14].

In response, the examiner asserts that appellants' interpretation of the claimed "onboard system" corresponds to an onboard system contained in a mobile vehicle, and that such interpretation impermissibly reads limitations from the specification into the claims [answer, page 5, emphasis added]. The examiner further contends that the client communication device can be contained in a mobile vehicle because it is well known to equip mobile vehicles with communication devices such as car phones [answer, page 5].

"During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification." In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1358, 49 USPQ2d 1464, 1467 (Fed. Cir. 1999). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993). The Court of Appeals for the Federal Circuit has recognized that the distinction between using the

specification to interpret the meaning of a claim and importing limitations from the specification into the claim can be a difficult one to apply in practice. Phillips v. AWH Corp., 415 F.3d 1303, 1323, 75 USPQ2d 1321, 1334 (Fed. Cir. 2005) (en banc), citing Comark Communications, Inc. v. Harris Corp., 156 F.3d 1182, 1186-87, 48 USPQ2d 1001, 1005 (Fed. Cir. 1998) ("there is sometimes a fine line between reading a claim in light of the specification, and reading a limitation into the claim from the specification"). In Phillips, the court noted: "However, the line between construing terms and importing limitations can be discerned with reasonable certainty and predictability if the court's focus remains on understanding how a person of ordinary skill in the art would understand the claim terms" [emphasis added]. Phillips, 415 F.3d at 1323, 75 USPQ2d at 1334.

We note that it is the job of the examiner, as the finder of fact, to determine how a person of ordinary skill in the art would understand the claim terms at the time of the invention. After carefully considering all the evidence before us, we agree with the examiner that appellants' interpretation of the claimed "onboard system" impermissibly reads limitations from the specification into the claims. We note that the claim term "onboard" is a relative term subject to a broad reasonable interpretation that generally specifies a physical relationship or proximity between two or more objects or entities. This broad, but reasonable, construction is entirely consistent with the disclosure in the instant specification of an "onboard system contained in mobile vehicle 140" [specification, page 5, line 20]. Furthermore, we agree with the examiner that a person of ordinary skill in the art would understand the disputed term "onboard system" as

having a broader scope than the meaning appellants attempt to impute by argument. We therefore agree with the examiner that a broad but reasonable interpretation of the claimed "onboard system" fairly reads upon Kiel's handheld client communication device 102 [Kiel, Fig. 1, ¶¶0034, 0036]. We further note that CPU 114 comprises a system located onboard handheld client communication device 102 and that client communication device 102 is a portable device [*id.*, emphasis added].

Appellants appear to be arguing that the portable networking device definition found in the specification (discussed *supra*) requires, or at least implies, that the claimed "onboard system" must be contained in a mobile vehicle [brief, page 12, see also specification, page 5, lines 18-20, emphasis added]. We find that appellants are improperly imputing a specific meaning to one claim term ("onboard system") by relying upon a definition found in the specification for an entirely different claim term ("portable networking device") [instant claim 1]. We note that the instant specification is silent regarding an express or implied definition that disavows or disclaims the plain, ordinary and customary meaning associated with the phrase onboard system [emphasis added]. We further note that the instant claims are silent with respect to any recitation of a mobile vehicle.

The examiner contends that Kiel's client communication device can be contained in a mobile vehicle [answer, page 5]. We agree with the examiner that an artisan reading the Kiel reference would readily understand that portable phones are carried by people who travel

onboard trains, planes, and automobiles, and also that this type of application is a common intended use or function for the portable phone disclosed by Kiel [emphasis added].

The Court of Appeals for the Federal Circuit has determined that the absence of a disclosure relating to function does not defeat a finding of anticipation if all the claimed structural limitations are found in the reference. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). In Schreiber, the court held that a funnel-shaped oil dispenser spout anticipated a claimed conical-shaped popcorn dispensing top, even though the function of popcorn dispensing was not taught by the reference, because the reference met all the structural limitations of the claim. In re Schreiber, 128 F.3d at 1479, 44 USPQ2d 1429 at 1433.

Assuming, *arguendo*, as appellants assert, that because Kiel does not teach a system that is onboard a mobile vehicle that Kiel cannot anticipate the claimed "onboard system," we note that the state of being onboard a mobile vehicle is merely an intended use or function for Kiel's portable handheld communication device (i.e., "system") [claim 1, emphasis added].

Significantly, we note that the structure of Kiel's portable handheld communication device does not change according to its particular location (i.e., whether the communication device is onboard a vehicle or not) [emphasis added]. Accordingly, because the absence of a disclosure relating to an intended use or function does not defeat a finding of anticipation, we will sustain the examiner's anticipation rejection for essentially the same reasons argued by the examiner [emphasis added].

For at least the reasons discussed *supra*, we will sustain the examiner's rejection of all the claims in Group I (claims 1, 5, and 9).

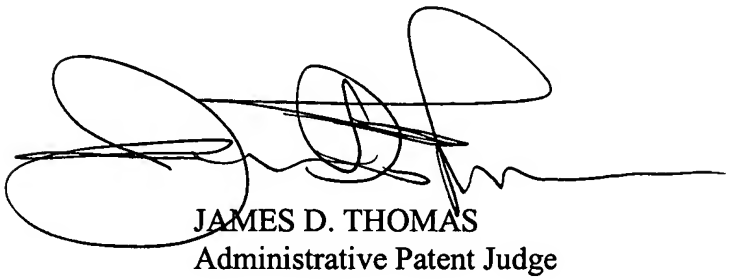
Group II, claims 2-4, 6-8, and 10-12

We next consider Group II consisting of dependent claims 2-4, 6-8, and 10-12. We note that appellants have presented these claims under a separate heading, but have failed to argue the limitations of each dependent claim separately from the independent claims in Group I. Because we have sustained the examiner's rejection of the independent claims in Group I, we will likewise sustain the examiner's rejection of the dependent claims for the same reasons discussed *supra* with respect to the claims in Group I.

In summary, we have sustained the examiner's rejection of all claims under appeal. Therefore, the decision of the examiner rejecting claims 1-12 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED.



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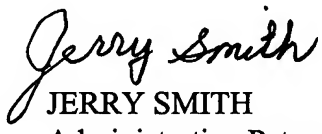
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